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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,967	10/24/2003	Robert Garrett	GARR-0009	6974
21261	7590	09/27/2005	EXAMINER	
ROBERT PLATT BELL P.O. BOX 310 AURORA, NY 13026			BLAKE, CAROLYN T	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,967

Applicant(s)

GARRETT, ROBERT

Examiner

Carolyn T. Blake

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10-13, 19 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 14-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species IV and B in the reply filed on August 17, 2005 is acknowledged.

Specification

2. The abstract of the disclosure is objected to because it contains legal language, specifically the word "comprises" in line 2. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

- Page 5, line 6: "side view" should be changed to - -perspective view- -.
- Page 5, line 9: "side view" should be changed to - -perspective view- -.
- Page 10, line 7: Reference number "932" should be changed to - - 934- -.
- Page 10, line 11: Reference number "932" should be changed to - - 934- -.
- Page 12, line 21: A period should be added to the end of the sentence.
- Page 16, line 4: The sentence refers to "Figures 11 and 183."

However, Figure 183 does not exist.

Appropriate corrections are required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the rotary housing" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shearon et al (4,685,214).

Shearon et al disclose a saw comprising: an air motor (22) for receiving compressed air and driving a rotary shaft (32); a saw blade (42), coupled to the

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rotary housing; and a saw housing (224), adjustably coupled to the air motor (22), for controlling a depth of cut of the saw blade (42).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 1 above and in further view of Lee (1,955,137) and Zimmerman (4,561,477).

Shearon et al disclose the blade (42) has 4 to 8 teeth. Shearon et al fail to disclose the diameter of the blade or a carbide bit. However, Lee discloses a saw blade used to cut shingles (col. 1, line 5) wherein the blade diameter is three inches or greater. In addition, a blade with a diameter within the parameters claimed in order to cut a small item and accommodate mobility would have been obvious to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a blade with a 3-3/8" to 5" diameter, as disclosed by Lee, for the purpose of cutting a small object and accommodating mobility.

In addition, Zimmerman discloses a saw blade with carbide bits (52). The addition of carbide to a blade retains the cutting sharpness for a longer period of

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time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Shearon et al blade with carbide bits, as disclosed by Zimmerman, for the purpose of retaining blade sharpness.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 1 above, and further in view of Kelly (5,974,674).

Shearon et al fail to disclose a grinder motor. However, Kelly discloses a grinder motor for use in a hand-held saw. The grinder motor creates vibration that is useful in cutting thick or hard material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide grinder motor, as disclosed by Kelly, on the Shearon et al saw for the purpose of easing a cutting operation.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Kelly as applied to claim 3 above, and further in view of Barrett et al (5,460,071).

Shearon et al disclose the motor (22) further includes an on-off valve (52) coupled to an activation lever (54), but the Shearon-Kelly combination fails to disclose a safety latch. Barrett et al disclose a safety latch (55) in conjunction with a lever arm (50) and valve (45). The safety latch prevents unwanted actuation of the valve. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a safety latch, as

disclosed by Barrett et al, on the Shearon-Kelly combination for the purpose of preventing unwanted actuation of the valve.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 1 above, and further in view of Zimmerman.

Shearon et al fail to disclose the blade thickness. Zimmerman discloses a blade that is 0.25 inches thick (col. 4, lines 58-59). In addition, it would have been obvious to make a blade with the thickness claimed in order to cut through a work piece easily with minimal blade deflection or deformation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Shearon et al blade 0.25 inches thick in order to cut through a work piece easily with minimal blade deflection or deformation.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Nitz et al (5,265,340).

Shearon et al disclose the invention substantially as claimed (see rejection to claim 1), but fail to disclose the use of the device for cutting roofing materials. Nitz et al disclose a hand-held saw with a circular blade wherein the device can be used to cut roofing materials (specifically shingles, see col. 2, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Shearon et al device with another work product, such as the shingles disclosed by Nitz et al.

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15. Claims 15, 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 14 above and in further view of Lee (1,955,137) and Zimmerman (4,561,477).

Shearon et al disclose the blade (42) has 4 to 8 teeth. Shearon et al fail to disclose the diameter of the blade or a carbide bit. However, Lee discloses a saw blade used to cut shingles (col. 1, line 5) wherein the blade diameter is three inches or greater. In addition, a blade with a diameter within the parameters claimed in order to cut a small item and accommodate mobility would have been obvious to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a blade with a 3-3/8" to 5" diameter, as disclosed by Lee, for the purpose of cutting a small object and accommodating mobility.

In addition, Zimmerman discloses a saw blade with carbide bits (52). The addition of carbide to a blade retains the cutting sharpness for a longer period of time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Shearon et al blade with carbide bits, as disclosed by Zimmerman, for the purpose of retaining blade sharpness.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 14 above, and further in view of Kelly (5,974,674).

Shearon et al fail to disclose a grinder motor. However, Kelly discloses a grinder motor for use in a hand-held saw. The grinder motor creates vibration

that is useful in cutting thick or hard material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide grinder motor, as disclosed by Kelly, on the Shearon et al saw for the purpose of easing a cutting operation.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al in view of Kelly as applied to claim 16 above, and further in view of Barrett et al (5,460,071).

Shearon et al disclose the motor (22) further includes an on-off valve (52) coupled to an activation lever (54), but the Shearon-Kelly combination fails to disclose a safety latch. Barrett et al disclose a safety latch (55) in conjunction with a lever arm (50) and valve (45). The safety latch prevents unwanted actuation of the valve. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a safety latch, as disclosed by Barrett et al, on the Shearon-Kelly combination for the purpose of preventing unwanted actuation of the valve.

18. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearon et al as applied to claim 14 above, and further in view of Zimmerman.

Shearon et al fail to disclose the blade thickness. Zimmerman discloses a blade that is 0.25 inches thick (col. 4, lines 58-59). In addition, it would have been obvious to make a blade with the thickness claimed in order to cut through a work piece easily with minimal blade deflection or deformation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to make the Shearon et al bale 0.25 inches thick in order to cut through a work piece easily with minimal blade deflection or deformation.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 22, 2005



Allan N. Shoap
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